

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

BRINK'S NETWORK, INCORPORATED,

Opposer,

v.

THE BRINKMANN CORPORATION,

Applicant.

76/483,115

Opposition No. 91164764

**APPLICANT BRINKMANN'S OPPOSITION TO OPPOSER'S
MOTION TO DEFER CONSIDERATION OF APPLICANT'S
MOTION FOR SUMMARY JUDGMENT**

I.



11-10-2008

INTRODUCTION

U.S. Patent & TMO/CTM Mail Rpt Ct #30

Applicant The Brinkmann Corporation ("Brinkmann") respectfully submits this opposition to the motion to defer consideration of Applicant's motion for summary judgment to dismiss Opposer's dilution claim pending a ruling on the motion for summary judgment filed by Opposer Brink's Network, Incorporated ("Brink's Network") to dismiss Applicant's affirmative defense of laches.

Once again, Opposer Brink's Network has burdened the Board and Applicant Brinkmann by bringing a motion that is unnecessary and unsupported by the law. Opposer alleges that Applicant's motion for summary judgment is not proper because it violates the

Board's Order of August 19, 2008. In the Order, the Board suspended proceedings and stated that "[a]ny paper filed during the pendency of [Opposer's motion for summary judgment] which is not relevant thereto will be given no consideration." Opposer Brink's Network alleges that Applicant's summary judgment motion is not "relevant" to Opposer's own summary judgment motion. In fact, however, Opposer's summary judgment motion to dismiss Applicant's laches defense is based, in part, on the same issue that Applicant's summary judgment motion to dismiss Opposer's dilution claim focuses on, namely, whether or not Opposer Brink's Network is guilty of laches in bringing its dilution claim. The Board cannot rule on one motion without having to revisit the same issue and rule again on the second motion. It cannot be alleged, then, that Applicant's motion is not relevant to Opposer's motion.

Opposer Brink's Network merely seeks to delay its inevitable loss, because Opposer Brink's Network's dilution claim is fatally flawed. Applicant Brinkmann secured a registration for BRINKMANN nearly 30 years ago, before dilution even became a ground for opposition or cancellation of a federal registration. The registration is now incontestable. Applicant Brinkmann then secured a second registration for BRINKMANN BACKYARD KITCHEN, which is not yet incontestable but which Opposer has never objected to or petitioned to cancel even after dilution became a cognizable ground for opposition or cancellation. Any dilution that Opposer Brink's Network alleges is likely to occur through Applicant's present application would, in fact, already have occurred through Applicant's pre-existing registrations for BRINKMANN. In raising the ground of dilution against Brinkmann's pending application, Opposer Brink's Network is trying to "lock the barn door" long after the horse has bolted, a futile exercise that should be summarily dismissed.

Furthermore, Opposer Brink's Network has not asserted any prejudice resulting from the Board's concurrent consideration of Opposer's and Applicant Brinkmann's respective motions. The lack of prejudice to Opposer and the logical necessity and judicial economy to the Board in considering the motions together warrant denial of Opposer's motion to defer consideration.

II.

PROCEDURAL HISTORY

On November 13, 1978, Brinkmann filed an application, Ser. No. 73/193,053, for registration of its trademark BRINKMANN in a slightly stylized form.¹ The application was published on September 16, 1980, and it issued as Reg. No. 1,153,730 on May 12, 1981. The registered goods are "electrical extension cords, brackets, and electric connectors for use therewith," in International Class 9 (the same class at issue in this opposition proceeding), citing a date of first use of June 12, 1978, and "charcoal fired and electric roasting, grilling and barbecue cookers for domestic use and portable electric lights and filters, and replacement lamps," in International Class 11.

On October 11, 2000, Brinkmann filed an application, Ser. No. 76/145,244, for registration of its trademark BRINKMANN BACKYARD KITCHEN. The application was published on October 22, 2002 and issued as Reg. No. 2,779,986 on November 4, 2003, with a disclaimer of the words "backyard kitchen." The registered goods are "combined outdoor grill and kitchen appliance units comprised of gas grills, sinks and coolers," in International Class 11.

On January 17, 2003, Brinkmann filed the application at issue in this opposition, Ser. No. 76/483,115, for its trademark BRINKMANN in multiple classes to cover its then-

¹ The BRINKMANN mark in Reg. No. 1,153,730 has the final two "N"s joined together.

existing lines of goods. The application was published for opposition on October 5, 2004. The current description of goods covers a wide variety of goods, in different International Classes.

Opposer Brink's Network filed a NOTICE OF OPPOSITION on April 1, 2005.

Brink's Network objected to registration of BRINKMANN only in connection with "home security systems and components therefor, namely, motion sensitive home security lights, detectors, receivers, transmitters, adapters and wall mount brackets," in International Class 9. The grounds for opposition asserted by Brink's Network are (1) likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d) with various marks incorporating BRINK'S; and (2) dilution under Section 43(c) of the Trademark Act, 15 U.S.C. § 1125(c), of various marks incorporating BRINK'S.

On May 16, 2005, Applicant Brinkmann filed an ANSWER, denying all of the material allegations of Opposer's opposition notice and asserting laches as an affirmative defense.

On August 12, 2008, Opposer Brink's Network filed a motion for partial summary judgment to dismiss Applicant's affirmative defense of laches.

The Board issued an Order on August 19, 2008, suspending proceedings and stating that "[a]ny paper filed during the pendency of this motion which is not relevant thereto will be given no consideration."

On August 26, 2008, Opposer Brink's Network filed a motion to resume proceedings, arguing that suspension was not proper because Opposer's motion for partial summary judgment was not potentially dispositive of the proceedings.

The Board promptly issued an Order on September 12, 2008, denying Opposer's motion to resume proceedings. The Board stated that suspension was proper inasmuch as

Opposer's motion for partial summary judgment was potentially dispositive of an affirmative defense.

On September 23, 2008, Applicant Brinkmann filed a motion for partial summary judgment to dismiss Opposer's claim of dilution, based, in part, on the ground that Opposer is guilty of laches in bringing its dilution claim.

III.

ARGUMENT

A. **It is Proper for the Board to Consider Both Parties' Motions for Summary Judgment at the Same Time**

1. **Applicant's Motion for Summary Judgment to Dismiss Opposer's Dilution Claim is Relevant and Germane to Opposer's Motion for Summary Judgment to Dismiss Applicant's Laches Affirmative Defense**

Section 2.127(d) of the Code of Federal Regulations provides that when a party files a motion for summary judgment or any other motion which is potentially dispositive of a proceeding, the case will be suspended by the Trademark Trial and Appeal Board with respect to all matters not germane to the motion and no party should file any paper which is not germane to the motion. 37 C.F.R. § 1.127(d); *see also* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE ("TBMP") § 528.03. Examples of papers which are or may be germane to a motion for summary judgment include a brief in opposition to the summary judgment motion, a motion for an extension of time in which to respond to the summary judgment motion, a motion under Fed. R. Civ. P. 56(f) for discovery needed to enable the nonmoving party to respond to the summary judgment motion, a cross-motion for summary judgment, and a motion for leave to amend a party's pleading. TBMP § 528.03. Examples of papers which are not considered germane to a motion for summary judgment include a motion to compel discovery, a motion for discovery sanctions, and a motion to suspend for a civil action. *Id.* at footnote 391.

The reasoning behind the Board's directive is clear – if a motion is potentially dispositive of a proceeding, the Board does not wish to expend time and effort in deciding a subsequent motion if the first motion renders the subsequent motion irrelevant. Subsequent motions that involve the same issues as the first motion, however, are relevant and logically dictate consideration by the Board. *See, e.g., International Finance Corp. v. Bravo Co.*, 64 USPQ.2d 1597, 1603-04 (TTAB 2002) (motion to amend opposition germane inasmuch as it related to the issue of whether applicant's motion is one for complete or partial summary judgment).

Here, Opposer has failed to grasp what the Board considers "relevant" for purposes of deciding whether or not to consider a subsequently filed motion. Opposer Brink's Network argues that Applicant Brinkmann's motion for summary judgment to dismiss Opposer's dilution claim is not relevant to Opposer's motion to dismiss Applicant's affirmative defense of laches because Applicant's motion is "essentially directed to the merits" of Opposer's dilution claim, rather than to the laches defense. *See Opposer's Motion to Defer* at pp. 5-6.

Opposer Brink's Network fails to recognize, however, that Applicant's argument against the merits of Opposer's dilution claim is only one of the grounds in its motion. Applicant also addresses Applicant's laches defense against Opposer's dilution claim. Both motions, therefore, address the same overlapping issue of laches with respect to a dilution claim. Opposer's two asserted grounds for opposition in this proceeding are likelihood of confusion and dilution. Applicant has asserted the affirmative defense of laches against both grounds. Opposer's motion for summary judgment seeks to dismiss Applicant's laches affirmative defense against both grounds. Applicant's motion for summary judgment seeks to dismiss Opposer's dilution claim, based on the merits of Opposer's dilution claim and based on Opposer's laches in

bringing its dilution claim. Similar to the overlapping segments of a Venn diagram, both motions address the same overlapping issue, namely, whether or not Opposer has been guilty of laches in bringing its dilution claim.

Since both motions are inextricably tied to one another, the Board cannot rule on one motion without having to revisit the same issue and rule again on the second motion. Applicant's summary judgment motion must be considered relevant and germane, then, to Opposer's summary judgment motion.

2. Judicial Economy and the Lack of Prejudice to Opposer Favor Concurrent Consideration of the Summary Judgment Motions

Other than a mistaken interpretation of "relevance," Opposer Brink's Network cannot point to any other reason for deferring consideration of Applicant Brinkmann's summary judgment motion. Opposer Brink's Network certainly cannot point to any prejudice in having Applicant Brinkmann's motion heard concurrently with Opposer's own motion, since the same issue is present in both motions. In addition, Opposer Brink's Network previously filed a motion to resume these proceedings, presumably in order to expedite conclusion of these proceedings. Opposer's request to further delay these proceedings by deferring consideration of Applicant's motion is thus inexplicable and perplexing.

Moreover, the purpose of summary judgment is judicial economy, that is, to save the time and expense of a useless trial where no genuine issue of material fact remains and more evidence than is already available in connection with the summary judgment motion could not reasonably be expected to change the result. *See Pure Gold, Inc. v. Syntex (U.S.A.), Inc.*, 739 F.2d 624, 222 USPQ 741 (Fed. Cir. 1984), *citing Exxon Corp. v. National Foodline Corp.*, 579 F.2d 1244, 1246, 198 USPQ 407, 408 (CCPA 1978). Judicial economy is also served by efficient use of the Board's resources and time. Deferring consideration of Applicant's summary

judgment would force the Board to start all over again and review the same facts and rule on the same issue of laches on Opposer's dilution claim. Judicial economy is better served by having the Board consider both motions together and issue one comprehensive ruling.

For all of the reasons set forth above, Applicant Brinkmann respectfully requests that the Board deny Opposer's motion to defer consideration of Applicant's motion for summary judgment.

B. Opposer's Allegation that Applicant's Laches Defense is Fatally Flawed is Itself Incorrect

Opposer Brink's Network has ostensibly brought a motion simply to request deferment of Applicant's summary judgment motion. Yet, in its procedural motion, Opposer Brink's Network proceeds to attack the substantive merits of Applicant's laches defense. Applicant thus is compelled to respond on the merits.

Opposer Brink's Network asserts that Applicant's laches defense is flawed because (i) Opposer allegedly had good reason not to challenge Applicant's pre-existing registrations for BRINKMANN (Reg. No. 1,153,730) and BRINKMANN BACKYARD KITCHEN (Reg. No. 2,779,986); and (ii) Applicant's reliance on the *Morehouse* defense is misplaced. Both assertions are incorrect.

1. Opposer Never Objected to Applicant's Prior Registrations for BRINKMANN and BRINKMANN BACKYARD KITCHEN

To date, Opposer Brink's Network has never challenged Applicant's pre-existing registrations for BRINKMANN (Reg. No. 1,153,730) or BRINKMANN BACKYARD KITCHEN (Reg. No. 2,779,986).

Opposer Brink's Network makes much of the fact that dilution was not a cognizable ground for opposition or cancellation until the Trademark Amendments Act of 1999 ("TAA") and that only applications filed after January 16, 1996 can be challenged on dilution

grounds. Nor could Opposer have brought a dilution claim before the Board under a state dilution statute. Opposer states that Opposer could thus never have challenged Applicant's Reg. No. 1,153,730 for BRINKMANN, registered in 1981.² Significantly, the very inability alleged by Opposer to contest Applicant's registration constitutes an absolute bar to a dilution claim against Applicant's present application and any other future BRINKMANN applications filed by Applicant. Section 43(c) of the Lanham Act sets forth six factors to consider whether dilution by blurring is likely to occur. 15 U.S.C. § 43(c)(2)(B). Factor 3 is the extent to which the owner of the famous mark is engaging in substantially exclusive use of the mark. As Professor McCarthy notes:

This factor requires consideration of how unusual or exceptional is this mark. Consideration of third party uses is relevant both here, in determining if blurring is likely, as well as in the first instance in determining if a mark is "famous." A mark that is merely one of several identical or very similar marks is already "diluted" in fact. In such a case, the junior user's actions can hardly be said to be likely to cause any significant further "dilution" of such a mark. The theory of dilution by blurring is that a junior user's mark may blur the ability of the famous senior mark to clearly identify and distinguish only one source. If there are already several sources already identified by the same mark, then "blurring" has already occurred and this new challenged use is unlikely to cause any additional, illegal blurring.

J. Thomas McCarthy, 4 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 24:119 (4th ed.) (citations omitted).

² Opposer Brink's Network's defensive posture rings hollow to the extent that Opposer has also never objected to Applicant Brinkmann's use of BRINKMANN, even under the Federal Trademark Dilution Act of 1996. See Applicant's *Opposition to Opposer's Motion for Partial Summary Judgment to Dismiss the Affirmative Defense of Laches*, at p. 21.

Applicant Brinkmann's Reg. No. 1,153,730 for BRINKMANN is not technically a "third party" use; it is more devastating to Opposer than that because it is Applicant's own use. As such, it would be totally inconsistent to allow Opposer to oppose Applicant's pending application for BRINKMANN on the ground of dilution while accepting Opposer's excuse that there is nothing whatsoever it can do about Applicant's existing incontestable registration of BRINKMANN. The simple fact is that the existence of Brinkmann's registration of BRINKMANN for almost 30 years and its incontestability means that Opposer Brink's Network can never prove the exclusivity that Opposer needs to demonstrate alleged dilution. In essence, Opposer's BRINK'S mark is already "diluted" regardless of whether or not Opposer Brink's Network could have contested Applicant's registration 30 years ago.

Opposer further states that the earliest point at which Opposer had the opportunity to challenge Applicant's Reg. No. 2,779,986 for BRINKMANN BACKYARD KITCHEN was October 22, 2002, which is when the application was published for opposition. Opposer then states, "Thus, the period of any 'delay' is roughly thirty (30) months; namely, from October 22, 2002, when the application in question was published, until April 1, 2005, when the present opposition was commenced. A 'delay' of that magnitude generally does not rise to the level of laches in an opposition proceeding." See Opposer's *Motion to Defer* at p. 9. Opposer states that the four-year statute of limitations under 28 U.S.C. § 1658 applies to dilution claims under Section 43(c) of the Trademark Act, and that Opposer's "30-month" delay is presumptively reasonable under the federal statute of limitations.

Opposer Brink's Network, however, makes a gross misstatement. Applicant Brinkmann's Reg. No. 2,779,986 for BRINKMANN BACKYARD KITCHEN was indeed published for opposition on October 22, 2002, but Opposer has never filed an opposition or

cancellation proceeding against Applicant's BRINKMANN BACKYARD KITCHEN mark to the present day. See Applicant's *Opposition to Opposer's Motion for Partial Summary Judgment to Dismiss the Affirmative Defense of Laches*, at pp. 3-4. The date of April 1, 2005 on which Opposer focuses is merely the date that Opposer filed a notice of opposition against Applicant's present application for BRINKMANN, not against Applicant's Reg. No. 2,779,986 for BRINKMANN BACKYARD KITCHEN. Opposer Brink's Network clearly has had ample opportunity to file either an opposition or a cancellation proceeding against Applicant's Reg. No. 2,779,986 for BRINKMANN BACKYARD KITCHEN. Over six years have passed since that application was published for opposition, yet Opposer has never objected to it or to the subsequently issued registration. By Opposer's own definition, then, Opposer is guilty of laches with respect to Applicant's Reg. No. 2,779,986.

What is more, not only has Opposer Brink's Network never challenged Applicant Brinkmann's pre-existing BRINKMANN registrations, but Opposer conveniently ignores that it limited this very opposition to just a few goods in one class of Applicant Brinkmann's multi-class application. Despite alleging dilution as a ground of opposition, Opposer Brink's Network did not object to Applicant Brinkmann's application to register BRINKMANN either in connection with other goods in the same class as the opposed goods or in connection with any goods in the eight other classes of the application. This itself is fatal to Opposer Brink's Network's motion.

2. The Morehouse Defense is Applicable in a Dilution Context

Opposer Brink's Network also alleges that Applicant's reliance on the *Morehouse* defense is misplaced, because Applicant's two pre-existing registrations for BRINKMANN are not for the same goods as those challenged in the present application, namely home security

systems and components therefor. Opposer Brink's Network has a fundamental misunderstanding of Applicant Brinkmann's laches defense.

A laches defense in an opposition proceeding may be based upon the opposer's failure to object to an applicant's prior registration of substantially the same mark for substantially the same goods or services. *See, e.g., Acquion Partners L.P. v. Envirogard Products Ltd.*, 43 U.S.P.Q.2d 1371, 1373-74 (TTAB 1997); *Copperweld Corp. v. Astralloy-Vulcan Corp.*, 196 U.S.P.Q. 585, 590-91 (TTAB 1977); *White Heather Distillers Ltd. v. American Distilling Co.*, 200 U.S.P.Q. 466, 469 (TTAB 1978).

The traditional application of the affirmative defense of laches in an opposition is based on alleged likelihood of confusion. In such proceedings, the Board scrutinizes whether an applicant's prior registration that an opposer failed to oppose was for substantially the same mark for substantially the same goods or services. If an opposer believes a likelihood of confusion exists with a mark in a pending application, then the opposer should have opposed a previous application as well. The rationale for requiring the same mark for substantially the same goods or services is similar to the *Morehouse* affirmative defense, in that no added damage (*i.e.*, additional likelihood of confusion) to the opposer will result by issuing a registration to an applicant who already has a substantially similar existing registration. *See Morehouse Mfg. Corp. v. J. Strickland & Co.*, 160 U.S.P.Q. 715, 717 (CCPA 1969).

To be sure, the ground for opposition of dilution is not the same as the ground of likelihood of confusion. Likelihood of confusion compares use of a same or confusingly similar mark for the same or confusingly similar goods. Dilution, on the other hand, compares marks without regard to the similarity of the goods. Use is tied to any commercial use by a defendant, not just confusingly similar or objectionable use. *See Enterprise Rent-A-Car Co. v. Advantage*

Rent-A-Car, Inc., 330 F.3d 1333, 1336 (Fed. Cir. 2003); *Nissan Motor Co. v. Nissan Computer Corp.*, 378 F.3d 1002, 1013 (9th Cir. 2004) (holding that any commercial use of a famous mark in commerce is arguably a diluting use that fixes the time by which famousness is to be measured).

However, since Opposer Brink's Network's ground for opposition based on alleged dilution does not depend on use of the BRINKMANN mark on similar or related goods, the affirmative defense of laches based on Applicant Brinkmann's pre-existing registrations is applicable to a dilution claim regardless of whether the goods in the pre-existing registrations are different from the goods in the opposed application.

Even when Opposer Brink's Network opposed Brinkmann's pending application, Brink's Network limited its opposition to "home security systems and components therefor, namely, motion sensitive home security lights, detectors, receivers, transmitters, adapters and wall mount brackets." Brink's Network did not object to the numerous other goods that Brinkmann applied for in its application, even though those goods are arguably as diluting as the challenged goods.

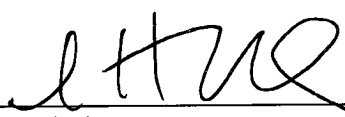
Any alleged "damage" through blurring caused by Applicant Brinkmann's registration of BRINKMANN now would be the same "damage" that occurred when Brinkmann registered its other BRINKMANN marks. If Opposer Brink's Network failed to object back then, it cannot be heard to object now. The prejudice to Applicant Brinkmann is manifest. Opposer Brink's Network's unreasonable delay in opposing Brinkmann's application for BRINKMANN coupled with the resulting prejudice to Brinkmann establishes the affirmative defense of laches with respect to Brink's Network's dilution claim.

IV.

CONCLUSION

For all of the foregoing reasons, Applicant Brinkmann has demonstrated that the Board should consider Applicant's summary judgment concurrently with Opposer's summary judgment motion. Accordingly, Applicant Brinkmann respectfully requests that the Board deny Opposer's motion to defer consideration of Applicant's motion for summary judgment to dismiss Opposer's dilution claim.

Dated: November 3, 2008



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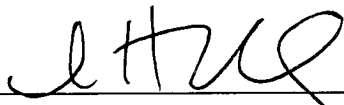
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THE BRINKMANN CORPORATION

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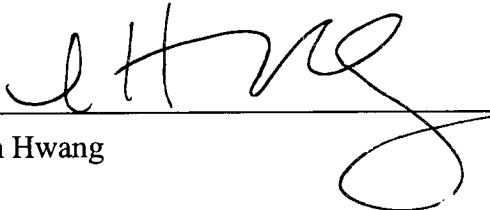
I hereby certify that the foregoing APPLICANT BRINKMANN'S OPPOSITION TO MOTION TO DEFER CONSIDERATION OF APPLICANT'S MOTION FOR SUMMARY JUDGMENT is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to the Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451, on November 3, 2008.



Susan Hwang

CERTIFICATE OF SERVICE

This is to certify that I have this day, November 3, 2008, caused to be served a copy of the foregoing APPLICANT BRINKMANN'S OPPOSITION TO MOTION TO DEFER CONSIDERATION OF APPLICANT'S MOTION FOR SUMMARY JUDGMENT by placing a copy in the United States Mail, postage pre-paid, addressed as follows: Nancy S. Lapidus, counsel for Opposer, at Howrey LLP, 1299 Pennsylvania Avenue, N.W., Washington, DC 20004.



Susan Hwang